



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,537	03/12/2002	Udo Skerdi	P-1105	4019

7590 12/17/2002

Scott R Cox
Lynch Cox Gilman & Mahan
400 West Market Street Suite 2200
Louisville, KY 40202

EXAMINER

MILLER, EDWARD A

ART UNIT PAPER NUMBER

3641

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N . 10/009,537	Applicant(s) SKERDI, UDO	
	Examiner Edward A. Miller	Art Unit 3641	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 4-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3641

1. The substitute specification has not been entered because it does not conform to 37 CFR

1.125(b), because: There is no marked up copy, nor any statement the there is no new matter.

37 CFR 1.125 (b) A substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by:

- (1) A statement that the substitute specification includes no new matter; and
- (2) A marked up version of the substitute specification showing all the changes (including the matter being added to and the matter being deleted from) to the specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.
- (c) A substitute specification submitted under this section must be submitted in clean form without markings as to amended material. The paragraphs of any substitute specification, other than the claims, should be individually numbered in Arabic numerals so that any amendment to the specification may be made by replacement paragraph in accordance with § 1.121(b)(1).

Likewise, the claim amendments have not been entered, for failure to comply with 37 CFR 1.121(c).

(c) Claims. —

- (1) Amendment by rewriting, directions to cancel or add. Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.
 - (i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., “amended,” “twice amended,” or “new”).
 - (ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., “amended,” “twice amended,” etc. The parenthetical expression “amended,” “twice amended,” etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.
- (2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.
- (3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up version will constitute an assertion that it has not been changed relative to the immediate prior version.

Art Unit: 3641

The new claims were evidently presented as part of the improper substitute specification. They lacked any indication of (new), or otherwise as required by rule. It is noted that there is an ostensible preliminary amendment, which has not been entered. While on page 2, line about 4 thereof there is a phrase "without adding any new subject matter," this is insufficient and does not conform to the rule, as new matter may result from changes other than adding, such as canceling or mistranslating. Further on said page 2, is found that "The applicant cancels all claims ..." This is not a "direction to cancel or add," nor a clear instruction for the Office to do anything. It is the USPTO which makes changes or amendments, upon the clear direction of applicant to do so in accordance with the rules. Applicant has not complied with the requirements of the rules.

2. New corrected drawings are required in this application because they are in poor drafting form including improper crosshatching, and cannot be readily understood. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feeder mass must be shown. No new matter may be entered. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. See also the 35 USC 112 rejection below. Further, the drawings lack reference numbers to help understand the claimed invention.

Art Unit: 3641

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The specification is objected to, 37 CFR 1.74, for lack of a brief description of the drawings.

§ 1.74 Reference to drawings.

When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures and to the different parts by use of reference letters or numerals (preferably the latter).

5. Applicant is required, in accordance with the duty of disclosure, to disclose the earliest publication of the instant invention. This is especially the case for any publication that is prior to March 12, 2001. What was then submitted to the Office stands perfected. Applicant is required to state any authority they may be aware of for submitting a changed translation of their application, should there be any change from what was originally submitted to the USPTO for purposes of obtaining their filing date of March 12, 2002. It is not clear from the record what copy was actually submitted, or even the language thereof. Clarification of these matters is required. See MPEP 2004, e.g., item number 14. Such a publication prior to March 12, 2001 requires examination in accordance with *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971), and *In re deSeversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). See MPEP 2162 et seq. As to corrections, see MPEP 2163, including: “while there is no in haec verba requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).”

Art Unit: 3641

6. Claims 4-10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim shall not form the basis for another multiple dependent claim. See MPEP § 608.01(n). Accordingly, these claims have not been further treated on the merits.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is required by “feeder mass”. It is not sure if this is a term of art, or requires a shaped body, or what. From Scherer, this would seem to require a specific type and general shape of a feeder mass body. Was this intended? From the art found, as understood, this would exclude such things as the heat insulating board of Takashima ‘526, the powder composition of Takashima ‘219, the refractory, exothermic composition of Neu ‘800, the exothermic sleeves of Menon, the pressed body of Benson, of the ribs of Butler et al. In any event, the metes and bounds of this term are indefinite and cannot be determined.

In claim 1, lines 2-4, what is required by “roughly”, all instances? What does “essentially free” of fluoride fluxes? This term of "essentially free" in claim 1 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a proper standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. As to the specification page 2 definition, see the next paragraph. What is intended by “reactive aluminum oxide”?

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does

Art Unit: 3641

not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 3 recites the broad recitation of the ranges of amounts for six ingredients, and the claim also recites "preferably" ranges, with different, smaller ranges for each, which is the narrower statement of the range/limitation. Further, to the extent that "essentially free" above is defined by specification page 2, this applies likewise to the three different taught ranges for "essentially free". Thus, the metes and bounds cannot be ascertained.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-3 rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling, and for lacking a proper description of the invention.

Applicant refers to German DE-C-25 32 745 in the specification as teaching a feeder mass, and what applicant intends for "feeder masses" and for "activated aluminum oxide" is critical or essential to the practice of the invention, but not included in the claim(s), and apparently this is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant

Art Unit: 3641

may not incorporate critical matter by reference to a foreign publication, to the extent that this was done. See MPEP 608.01(p), the incorporation by reference section.

Further, applicant does not properly teach what “reactive aluminum oxide” is, other than by certain particle sizes. Is this what is required to be reactive? The specification does not teach what is meant by “essentially free” of fluoride. There are three different ranges, and it cannot be determined what is correct. Further, aluminum oxide, Al_2O_3 , does not have any fluoride. To the contrary, the implication of the “essentially free” recitation is that there is some fluoride. As it is not disclosed or enabled what applicant intends as reactive aluminum oxide, one of ordinary skill cannot reasonably practice the invention. It appears that applicant uses a special kind of alumina, but conceals the details thereof. Further, what applicant intends as the “feeder mass” is not disclosed. This does not provide a proper description of the invention, or enable one of ordinary skill in the art to practice the invention.

Further, it may be that applicant, in providing one or more of the versions of the specification, may have changed the description of the invention or the language of the claims. However, since the examiner does not know at this time what was the version of the specification that was filed to obtain the filing date, this cannot be checked at this time. There is a clear possibility of new matter being introduced at some point, to the extent that changes were made. In this regard, note paragraph 5 above, as to *In re Oda* and the basis for corrections or changes. While certain corrections might be found proper, there is no *carte blanche* to “do over”.

11. The spacing of the lines of the specification and claims is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required. See 37 CFR 1.52.

Art Unit: 3641

12. It has been held improper, indeed, reversible error, to rely on speculation as to the meaning of indefinite claims, and then reject that speculative meaning on prior art. *In re Steele*, 305 F.2d 858, 134 USPQ 292 [CCPA 1962], *Ex parte Brummer*, 12 USPQ2d 1653 at 1655 [USPTO BOPAI 1989]. Therefore, since it cannot be determined what the applicant's invention is, action as to prior art is not taken at this time.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
December 12, 2002



EDWARD A. MILLER
PRIMARY EXAMINER